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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,704	01/29/2002	Tullio Rossini	ACO 2849 US	5948

7590

04/24/2003

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EXAMINER

VIJAYAKUMAR, KALLAMBELLA M

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,704

Applicant(s)

ROSSINI ET AL.

Examiner

Kallambella Vijayakumar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 2-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

- Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) based on the application filed at EPO with Sl. No. 01200314.1 filed 01/29/2001. Receipt is acknowledged of papers and the certified copy of the application submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
- Claims 1-15 are currently pending with the application.
- The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
- The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

Claims 2-15 are objected to because of the following informalities: As dependent on rejected base claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "*coating composition*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Public will not be able to make use of the invention without the burden of undue experimentation. It is not clear whether the term "coating composition" encompasses coating of a dry powder composition or coating of a powder dispersed in a vehicle forming either a paste or paint.

The examiner gives the broadest interpretation for the term "coating composition" and construes the term to include any coating composition comprising of conductive powder for the purposes of examination. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. In *reMorris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In *re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also MPEP § 2111 - § 2111.01.

*Claim Rejections - 35 USC § 102**Claim Rejections - 35 USC § 103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-6, 8, 10, 12, 13, and 15 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Boyer et al (US Patent 5,085,931).

Boyer et al disclose a coating composition for a radiation absorber comprising a dispersion of filaments of Fe, Ni, Co and their alloys including Fe-Ni, Ni-Mn, Fe-Cr in a polymer binder. The l/d ratios for the filaments vary from 10-50, and the amount of the metal fiber content being about 25% by volume in the formulation (Col-2, Lines: 1-18; Col-3, Lines: 10-14, 29-38; Col-5, Lines: 19-33). The anti-static property of the coating composition would be inherent, as metallic fillers have been used in the art, in formulating such compositions as disclosed by Yoshizumi et al (JP 63-046258). All the limitations of the instant claims are met.

The reference is anticipatory.

In the alternative that the disclosure by Boyer et al be insufficient to arrive at the instant claims, it is in the purview of a skilled artisan to make obvious modifications in composition by varying the amount of the filament and/or optionally choosing the stainless steel as the filler as suggested by Boyer to arrive at the instant claims of the applicants.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Komasa et al (JP 62-018481) or Tomono et al (JP 62-197473).

Komasa et al disclose a coating composition comprising of a dispersion consisting of an electrically conductive filler of stainless steel fibers with 2-50 micron diameter and 0.3-2 mm long in methacrylate binder dispersed in toluene as solvent. The ratio of conductive filler to the polymer was in the range of 1/100 to 1/1 by weight (Abstract). The calculated l/d ratios of 40-150 from the l and d value ranges reported by the Komasa et al meet the ' l/d ' limitations of the instant claims by the applicants. The antistatic property for the coating composition would be inherent, as stainless steel has been used as filler in the art in formulating such compositions as disclosed by Yoshizumi et al (JP 63-046258). All the limitations of the instant claims are met.

The reference is anticipatory.

Tomono discloses a conductive coating composition consisting of a dispersion of a resin vehicle and metallic fillers such as nickel or stainless steel fibers in the amounts of 0.01-30 wt% based on the solids, with a diameter of 0.1-60 microns and a length of 0.1-5 mm. The coating functioned as an antistatic material, with improved conductivity imparted by a metallic filler to a non-conducting matrix such a resin binder. The range of ' l/d ' values for the fibers calculated from the values by Tomono et al falls in the range of l/d values per the limitations of the claims by the applicants. All the limitations of the instant claims are met.

The reference is anticipatory.

In the alternative that the disclosure by either Komasa et al or Tomono et al be insufficient to arrive at the instant claims, it is in the purview of a skilled artisan in the art

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to make minor modifications in composition based on the choice of design to obviously arrive at the instant claims of the applicants.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 703-305-4931. The examiner can normally be reached on M-Th, 07:00 - 15.30 hrs, Fri: 05.30-14.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

KMV
April 18, 2003


Mark Kopec
Primary Examiner